



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09.981.045	10/16/2001	Werner Obrecht	Mo6686/LcA 34,923	6800

157 7590 05/22/2003

BAYER POLYMERS LLC
100 BAYER ROAD
PITTSBURGH, PA 15205

EXAMINER

BUTTNER, DAVID J

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,045

Applicant(s)

OBRECHT ET AL.

Examiner

David Buttner

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claims 1-3 and 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"Mixture consisting of resorcinol and formaldehyde" in claims 1, 10 and 11 is confusing. How does "consisting of" limit the claims? Overall the claim "comprises" (A), (B) and (C). Later claims call for additional substances such as silica. The phrase would exclude applicant's own examples as a mixture of resorcinol and stearic acid is used (Cohedur RS) in the examples.

"Formaldehyde" is confusing. Initially, claims, 1, 10 and 11 require formaldehyde to be added in (c). Later, these claims state the formaldehyde is in the form of paraformaldehyde or hexamethylene tetramine. Paraformaldehyde is a cyclic ether. Hexamethylene tetramine obviously has nitrogen atoms that formaldehyde does not have. These two compounds are not formaldehyde. They may break down to form formaldehyde and other compounds under the proper conditions, but they are not formaldehyde. If paraformaldehyde or hexamethylene tetramine are required to be used as (c), then the word "formaldehyde" should be removed from the claim.

Claim 3 calls for NBR not allowed for in claim 1.

Claims 1-3, 7, 8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Doran Patent in view of Obrecht '488 or '891.

Doran teaches tire tread compositions of rubber, silica, polyamine, aromatic hydroxy compound and methylene donor. The aromatic hydroxy can be phenol or

resorcinol (claim 1). The methylene donor may be hexamethylene tetramine or paraformaldehyde (claim 1).

Doran does not suggest including a crosslinked rubber gel in the tread composition.

Inclusion of such gels are known to improve rolling resistance and wet grip (Obrecht '891 col. 1, lines 40-49; Obrecht '488 col. 1, lines 30-38). It would have been obvious to include these rubber gels in Doran's tread for the expected improvement.

Applicant's arguments filed 4/9/03 have been fully considered but they are not persuasive.

Applicant states paraformaldehyde and hexamethylene tetramine are forms of formaldehyde as illustrated in Appendix A.

The response did not include any appendix. It is doubtful applicant could have provided any evidence to overcome the rejection. The three compounds have distinct structures. If paraformaldehyde or hexamethylene tetramine are required to be added as component (c), then "formaldehyde" should be replaced by "paraformaldehyde" and "hexamethylene tetramine" in the description of (c).

Applicant argues the "consisting of" language excludes the polyimines of Doran.

The "consisting of" is used in describing (c) only. The claims are "comprising" open to any extra ingredients such as auxiliary substances in dependent claim 7. Doran adds his polyimine separately from the resorcinol and hexamethylene tetramine (col. 4 lines 6-19). For these reasons, the polyimine of Doran is not excluded by claiming (c) "consists of". Oddly, applicant's own examples do not employ "a mixture consisting of

resorcinol and formaldehyde". The resorcinol and formaldehyde are added in subsequent steps (not as a mixture) and both include "extra" materials (e.g., stearic acid or silica).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 703-308-2403. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

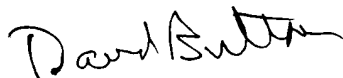
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Art Unit: 1712

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner/mn
May 21, 2003

A handwritten signature in black ink, appearing to read "David Buttner", written in a cursive style.